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EXAMINER

KRAMER, JAMES A

ART UNIT PAPER NUMBER

3627

DATE MAILED: 12/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/865,893	Applicant(s) STORCH ET AL	
	Examiner James A. Kramer	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's arguments, see Appeal Brief, filed 10/3/05, with respect to the rejection(s) of claim(s) 1-29 under 35 U.S.C 103(a) as being unpatentable over Tobin in view of Official Notice have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 11-24 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tobin in view of 'American Interactive Media and Shopping.com Announce Strategic Marketing Agreement' (hereinafter AIME).

With respect to **claim 1**, Tobin teaches providing members access to a co-branded Internet site including graphical user interface of the Internet service provider accessed through the Internet service site and one or more links to the Internet shopping site of the retailer (see for example column 9, lines 5-50 and column 16, lines 62-66). Examiner notes that while the specific embodiment includes the co-branding of Pathfinder and PC Flowers and Gifts, the invention includes embodiments that include an ISP (e.g. AOL) with a retailer.

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With further respect to **claim 1**, Tobin teaches providing members of the co-branded Internet site with incentives to access and shop on the Internet shopping site of the retailer through the co-branded Internet site (see for example column 13, lines 25-30)

With respect to **claim 1**, Tobin does not specifically teach wherein providing members incentives comprises providing members with a discount on subscription fees for access to the co-branded Internet site based upon quantity of merchandise purchased from the retailer.

AIME teaches a marketing agreement between American Interactive Media and Shopping.com (co-branded ISP, see for example Abstract lines 1-4) where customers accumulating "Maximizer Dollars" based on a quantity of merchandise purchased from Shopping.com and redeemable for discounted or free Internet access (see Full Text, lines 10-13).

It would have been obvious to one of ordinary skill in the art at the time of the invention modify the incentives taught by Tobin to include discounted or free Internet service based on quantity of merchandise purchased as taught by AIME. One of ordinary skill in the art would have been motivated to modify the references in order to offer shoppers a tremendous value of Internet access (see Full Text, lines 21-22).

With respect to **claim 2**, Tobin teaches wherein providing the co-branded Internet site includes providing a link to the Internet shopping site on all pages of the Internet service site (see for example column 9, lines 5-50 and Figures 11A-11C).

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With respect to **claim 3**, Tobin teaches providing a link to the Internet shopping site with icons comprising one or more trademark logos of the retailer (see for example column 9, lines 5-50 and Figures 11A-11C).

With respect to **claim 4**, Tobin teaches wherein the graphical user interface of the co-branded Internet site includes a tool bar, and the method further comprises locating a link to the Internet shopping site on the tool bar (see for example column 9, lines 5-50 and Figures 11A-11C).

With respect to **claim 5**, Tobin teaches wherein providing members incentives includes providing the members with a discount on merchandise purchased on the Internet shopping site accessed through the co-branded Internet site (see for example column 13, lines 25-30).

With respect to **claims 11 and 12**, Tobin teaches distributing software for the co-branded Internet site on the Internet shopping site and distributing software for the co-branded site on the Internet service site of the Internet service provider (see for example column 5, lines 60-66). Examiner notes that “available through a hypertext link” represents distributing as claimed by Applicant.

With respect to **claim 13**, Tobin teaches the co-branded Internet site with designations of the retailer and the Internet service provider (see for example column 5, lines 60-65). Examiner

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notes that “customized in graphic and content format to reflect both . . . brand names” represents designations of the retailer and the Internet service provider.

With respect to **claim 14**, Tobin teaches co-branded software for accessing the co-branded Internet site (see for example column 5, lines 1-17). Examiner notes that a co-branded web-site represents co-branded software.

With respect to **claim 15**, Tobin teaches advertising the co-branded Internet site on the Internet service site of the Internet service provider (see for example column 5, lines 60-66). Examiner notes that placing a hypertext link represents “advertising” the site, as it educes customers to visit the site.

With respect to **claim 16**, Tobin teaches providing the co-branded Internet site with a tool bar having a link to a menu list of a member’s regularly used links and including an icon on the tool bar that is linked to the Internet shopping site (see for example Figure 11A).

With respect to **claim 17**, Tobin teaches wherein the icon comprises logos of the retailer (see for example figure 21B and column 5, lines 60-66).

With respect to **claim 18**, Tobin teaches providing the co-branded Internet site with retailer channel links to ISP channel page content of interest to one or more demographic groups of members (see for example Figure 11A).

With respect to **claim 19**, Tobin teaches providing the Internet shopping site with retailer channel links to ISP channel page content of interest to one or more demographic groups of members (see for example Figure 11A). Examiner notes that a shopping site with links to ISP channel content represents a co-branded site.

With respect to **claim 20**, Tobin teaches providing the Internet shopping site with retailer channel links to non-ISP channel page content (see for example Figures 2-9). Examiner notes that this merely represents a shopping site with links.

With respect to **claim 22**, Tobin teaches providing the co-branded Internet site with links to departments within stores operated by the retailer (see for example Figure 11C).

With respect to **claim 23**, Tobin teaches wherein the links to the departments at the stores include order requests (see for example Figure 11C).

With respect to **claim 24**, Tobin teaches providing the co-branded Internet site with links to affiliates of the retailer (see for example Figure 11A).

With respect to **claim 31**, Examiner finds claim 31 to be substantially similar to claim 1 and therefore references the analysis for claim 1.

Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tobin in view of AIME as applied to claim 1 above, and further in view of Staples.com

With respect to **claim 6**, the combination of Tobin in view of AIME, as described above teaches all the limitations of claim 6 except wherein providing members incentives comprises providing members with access to advertising circular content for the Internet shopping site through the co-branded Internet site before corresponding printer.

Staples.com teaches providing advertising circulars on the Internet prior to distributing the printed versions (see “Staples Specials for 2/29/00”). Examiner notes that one of ordinary skill in the art would recognize that this is done in order to drive traffic to the site.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Tobin to include providing users with electronic versions of advertising circulars prior to distributing the printed versions as taught by Staples.com in order to drive traffic to the site.

With respect to **claim 7**, the combination of Tobin in view of AIME, as described above teaches all the limitations of claim 7 except wherein providing members incentives comprises providing members with notice of store-base clearances, promotional events and/or special events through the co-branded Internet site before publishing notices for such special events to non-members.

Staples.com teaches publishing to registered users (members) News and Hot Offers before publishing to non-registered users (non-members) (see for example News and Hot

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Offers). Examiner notes that News and Hot Product Offers represents Applicant's notice of store-base clearances, promotional events and/or special events. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Tobin to provide registered users with News and Hot Offers notices before non-registered users as taught by Staples.com. One of ordinary skill in the art would have been motivated to modify the references in order to entice customers to register.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tobin in view of AIME as applied to claim 1 above, and further in view of "AOL, Wal-Mart next to team on Net service" by Sandeep Junnakar (hereinafter Junnakar).

With respect to **claim 10**, the combination of Tobin in view of AIME, as described above teaches all the limitations of claim 10 except wherein the retailer operates retail stores and the method further comprises distributing software for the co-branded Internet site at the retail stores.

Junnakar teaches a co-branded website between ISP AOL and retailer Wal-Mart including the distribution of software at the retail establishment. Examiner notes that this is done in order to give those that have never been on the Net a sense of security.

It would have been obvious to one of ordinary skill in the art at the time of the invention modify the teachings of Tobin to include a retailer such a Wal-mart and to distribute software at the retail location as taught by Junnakar. One of ordinary skill in the art would have been motivated to modify the references in order to give those that have never been on the Net a sense of security.

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Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tobin in view of AIME as applied to claim 1 above, and further in view of OfficeDepot.com.

With respect to **claim 21**, the combination of Tobin in view of AIME, as described above teaches all the limitations of claim 21 except including a link to an application for a proprietary credit card issued by the retailer.

OfficeDepot.com teaches a including on a website a link to an Application for an Office Depot Credit card. One of ordinary skill in the art would recognize that this is done in order to entice customers to apply for a credit card.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the co-branded website of Tobin to include a link to an application for a proprietary credit card issued by the retailer as taught by OfficeDepot.com. One of ordinary skill in the art would have been motivated to modify the references in order to entice customers to fill out an application for a credit card.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tobin in view of AIME in further view of Junnakar as applied to claim 10 above, and further in view of "IBM to sell Aptiva direct" by Joe Wilcox (hereinafter Wilcox).

With respect to **claim 30**, the combination of Tobin in view of AIME and in further view of Junnakar, as described above teaches all the limitations of claim 30 except providing to members a link to news articles and a link to a page on the Internet shopping site offering for sale a product featured in the news article.

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Examiner offers the Wilcox article as evidence that prior to Applicant's invention it was old and well known to include within news articles links to product pages that sell the products featured in the article. Further Examiner notes that Tobin teaches links to news articles (see for example Figure 11A, "Latest News"). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the news articles of Tobin to include links to product pages to buy the products featured in the articles as taught by Wilcox to be old and well known technology. One of ordinary skill in the art would have been motivated to modify the references in order to market the products reported on.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tobin in view of AIME as applied to claim 1 above, and further in view of "Snafu prompts Microsoft to suspend some PC rebates" by Michael Kanellos (hereinafter Kanellos).

With respect to **claim 32**, the combination of Tobin in view of AIME, as described above teaches all the limitations of claim 32 except providing members with a discount on merchandise purchased wherein the rate of merchandise discount and period of time of which the discount is available varies on the basis of the length of member's subscription to the Internet service provider.

Examiner relies on Kanellos to teach that at the time of the Applicant's invention it was well known for Internet service providers to give customers discounts on products at affiliated retail stores based on the length of the customer's subscription to the Internet service provider. In this specific case, customer that agreed to a 3 year subscription were give a \$400 rebate to an

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affiliated retail store. Examiner further notes that one of ordinary skill in the art would have known that this was done to entice customers to sign up for lengthy subscriptions.

It would have been obvious to one of ordinary skill in the art at the time of the invention modify the teachings of Tobin to include providing a discount at PC Flowers (affiliated retailer) based on a length of subscription to an ISP as taught to be old and well known by Kanellos. One of ordinary skill in the art would have been motivated to modify the references in order to entice customers into lengthy subscription.

Response to Arguments

Applicant's arguments with respect to claims 1-7 and 10-32 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

"CompuServe faces end of rebate boost", Kanellos, Michael, 12/16/1999 found on www.news.com shows retailer discounts based on subscriptions to an ISP.

Applicant's amendment files 8/30/2004 necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

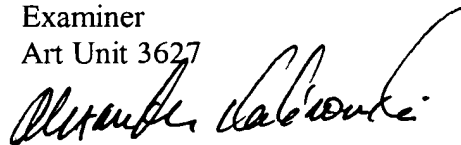
Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Kramer whose telephone number is (571) 272 6783. The examiner can normally be reached on Monday - Friday (8AM - 5PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272 6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jak

James A. Kramer
Examiner
Art Unit 3627



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